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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,420	11/12/2003	Darin G. Schaeffer	8627/327	7610
757	7590	11/01/2006		
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
			EXAMINER ZHENG, LOIS L	
			ART UNIT 1742	PAPER NUMBER

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,420

Applicant(s)

SCHAEFFER, DARIN G.

Examiner

Lois Zheng

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 15-22, 24-27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 9, 14, 23, 28, 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. No claims are amended in view of applicant's argument filed 11 August 2006.
Therefore, claims 1-33 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7, 10-11, 13, 15, 18, 20-21, 24-25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain EP 1,369,099 A2(Swain) in view of Boulanger et al. US 4,132,618(Boulanger).

The teachings of Swain in view of Boulanger are discussed in paragraph 6 of the previous Non-Final Office Action mailed 18 May 2006. The rejection grounds are maintained for the same reasons as stated in paragraph 6 of the previous Non-Final Office Action.

4. Claims 2, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain in view of Boulanger, and further in view of Baker et al. US 3,935,085(Baker).

The teachings of Swain in view of Boulanger and Baker are discussed in paragraph 7 of the previous Non-Final Office Action mailed 18 May 2006. The rejection

grounds are maintained for the same reasons as stated in paragraph 7 of the previous Non-Final Office Action.

5. Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain in view of Boulanger, and further in view of Wang et al. US 6,275,826 B1(Wang).

The teachings of Swain in view of Boulanger and Wang are discussed in paragraph 8 of the previous Non-Final Office Action mailed 18 May 2006. The rejection grounds are maintained for the same reasons as stated in paragraph 8 of the previous Non-Final Office Action.

6. Claims 12, 16, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain in view of Boulanger, and further in view of Moore US 5,145,474(Moore).

The teachings of Swain in view of Boulanger and Moore are discussed in paragraph 9 of the previous Non-Final Office Action mailed 18 May 2006. The rejection grounds are maintained for the same reasons as stated in paragraph 9 of the previous Non-Final Office Action.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swain in view of Boulanger and Moore, and further in view of Baker.

The teachings of Swain in view of Boulanger, Moore and Baker are discussed in paragraph 10 of the previous Non-Final Office Action mailed 18 May 2006. The rejection grounds are maintained for the same reasons as stated in paragraph 10 of the previous Non-Final Office Action.

Allowable Subject Matter

8. Claims 9, 14, 23, 28 and 32-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Reasons for indicating allowable subject matter:

The prior art of record do not teach or suggest, either alone or in combination, the claimed electro-polishing apparatus having at least two cathode loops that are spaced apart from each other.

The prior art of record also do not teach or suggest, either alone or in combination, the claimed electro-polishing apparatus wherein the anode is attached to a swing arm, said swing arm adapted to lift the anode and the medical implant/stent out of an electrolytic bath while the roller and cathode remains immersed.

Response to Argument

10. Applicant's arguments filed 11 August 2006 have been fully considered, but are not persuasive.

In the remarks, applicant argues that Boulanger does not relate to electropolishing medical implants art and the combination of Swain and Boulanger is a result of hindsight.

Swain teaches an electropolishing apparatus for polishing the inner surface of a stent(i.e. medical implant). Swain further teaches that the stent is rotated(see paragraph 6 of the previous Non-Final Office Action). Therefore, one of ordinary skill in the art at the time Swain's invention was made would have look into any art relating to

rotation of a tubular material(i.e. a stent is tubular) to ensure smooth and even rotation. Boulanger's apparatus is used in an electrolytic process for marking metallic parts, which is a similar process as an electropolishing process since both the electrolytic process of Boulanger and the electropolishing process of Swain are both metal removal processes utilizing electrical energy. More importantly, Boulanger is also concerned with rotation of a tubular material(i.e. metal tube in Boulanger) which is controlled by motor driven rollers. Therefore, one of ordinary skill in the art would have found it obvious to have incorporated the motor driven rollers as taught by Boulanger into the apparatus of Swain in order to permit free rotation of the metal tube(i.e. the stent) as taught by Boulanger. As to the size difference between the medical stent of Swain and the metal tube of Boulanger, one of ordinary skill in the art would have found it obvious to resize the rollers proportionally corresponding to the size of the medical stent in order to successfully adopting the rolling concept of Boulanger into the stent rotation of Swain. Therefore, the examiner does not find applicant's argument persuasive.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700